

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appln. No.	:	10/698,796	Confirmation No.:	1735
Applicant	:	DOUK, Nareak		
Filed	:	October 20, 2003		
TC/A.U.	:	3738		
Examiner	:	PRONE, Christopher		
Docket No.	:	P1704		
Customer No.	:	28390		
Title	:	Control Apparatus for Actuating an Elongate Medical Shaft		

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

ON APPEAL TO THE BOARD OF PATENT APPEALS AND INTERFERENCES

**ARGUMENTS ACCOMPANYING
PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Sir:

The appellant appeals the rejection of Claims 1-8 and 10-13 in the above-captioned application. These claims, as they appear in the Listing of Claims on pages 2-6 of the Amendment filed on August 2, 2006, were rejected in the Final Office Action dated October 13, 2006.

The following Arguments, beginning on page two (2), accompany the attached Pre-Appeal Brief Request for Review. No Amendments are being filed with these Arguments.

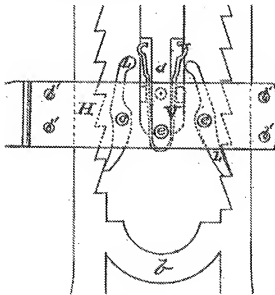
ARGUMENTS

35 U.S.C. §102 Rejections

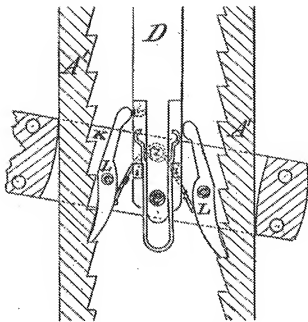
In the Final Office Action mailed October 13, 2006, claims 1-8 and 10-13 stand rejected as being anticipated by U.S. Patent No. 96,880 to Bull. Appellant avers that claims 1-8 and 10-13 are not properly rejected because the rejection has failed to point out, within the four corners of the reference, one or more essential elements needed for a *prima facie* rejection under 35 U.S.C. § 102.

The Bull Patent

As discussed at pages 7-8 in the Amendment filed August 2, 2006, Bull fails to disclose, *inter alia*, “an actuator assembly having first and second spaced-apart jaws adapted for releasably gripping the shaft,” as required, in part, by claim 1. The rejections mailed on May 24, 2006 and October 13, 2006 both argue that Bull’s dogs L, L correspond to the required jaws, and that lifting bar D corresponds to the required shaft. The latter of the two rejections states that “it is abundantly clear from figures 1 and 2 that the Jaws engage and release the shaft.” See Office Action mailed October 13, 2006, at page 3, line 2. Appellant avers that reliance on drawing figures alone is an improper basis for characterizing a reference, especially when the written description is contrary to the rejection’s characterization of the reference. Portions of Bull’s FIGS. 1 and 2 are provided below for convenience.



Bull FIG. 1 (partial)



Bull FIG. 2 (partial)

Although FIGS. 1 and 2 illustrate the upper ends of dogs L, L sometimes touching the lifting bar D, nowhere does Bull teach that dogs L, L “grip” bar D. Dogs L, L are not adapted in any way to act as gripping jaws, and, indeed such an adaptation would prevent Bull’s invention from operating as described.

Bull explains that the weight of bar D rests upon pin e, which is mounted between chucks H and K of operating lever G. See column 1, paragraph 8 and column 2, paragraph 5. Lever G is alternately operated as a first class lever when pushed down, or as a second class lever when pushing up. When lever G moves in either direction, bar D is raised by pin e, which moves vertically with respect to one of fulcrum pins c, c. As bar D rises, it must move, or slide with respect to the dog L that is under load via fulcrum pin c. If dogs L, L were to grip bar D, as supposed in the rejection, then Bull’s lifting jack could not lift anything. Thus, dogs L, L cannot be considered to be adapted for “releasably gripping” bar D, as required in part by claim 1. Claims 2-8 and 10 depend directly or indirectly from claim 1 and are patentable for the same reasons argued above with respect to claim 1.

Regarding claim 11, as discussed further at pages 7-8 in the Amendment filed August 2, 2006, Bull fails to disclose, *inter alia* “first and second spaced-apart jaws defining an opening therebetween for receiving and releasably gripping said medical shaft” as required by claim 11, in part. As argued above with respect to claim 1, Bull does not teach any elements corresponding

to the first and second spaced-apart jaws defining an opening there between for receiving and releasably gripping a shaft. Thus, Bull fails to disclose all the elements of claim 11. Claims 12 and 13 depend directly or indirectly from claim 11 and are patentable for the same reasons argued above with respect to claim 11.

The rejection also characterizes Bull as disclosing “another gripping surface b that is curved.” See Office Action mailed October 13, 2006, end of middle paragraph. The only element b in Bull is curved brace b disposed between rack bars A’, A’ near the bottom of the lifting jack. See FIG. 2 above. Appellant fails to comprehend how brace b can be considered to relate to the spaced-apart jaws claimed in the application.

In view of the above arguments, the rejection’s mischaracterization of the reference is untenable as a basis for arguing anticipation of the claims under 35 U.S.C. §102. The rejection has failed to point out one or more essential elements needed for a prima facie rejection, *i.e.* “an actuator assembly having first and second spaced-apart jaws adapted for releasably gripping the shaft.” Therefore, Appellants request that the rejection of claims 1-8 and 10-13 under 35 U.S.C. § 102(b) be reversed.

Respectfully submitted,

/James F. Crittenden, Reg. No. 39,560/
James F. Crittenden
Registration No. 39,560
Agent for Applicant
Customer No. 28,390
Telephone: 978.739.3075 (Eastern Time)

Medtronic Vascular, Inc.
3576 Unocal Place
Santa Rosa, CA 95403
Facsimile No.: (707) 543-5420